

1 SNELL & WILMER L.L.P.  
2 Philip J. Graves (SBN 153441)  
pgraves@swlaw.com  
3 Greer N. Shaw (SBN 197960)  
gshaw@swlaw.com  
4 350 South Grand Avenue, Suite 2600  
Two California Plaza  
Los Angeles, California 90071  
5 Telephone: (213) 929-2500  
Facsimile: (213) 929-2525

6 Attorneys for Plaintiff  
7 James R. Glidewell Dental Ceramics, Inc.  
d/b/a Glidewell Laboratories

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10  
11 UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA  
SOUTHERN DIVISION

12 JAMES R. GLIDEWELL DENTAL  
CERAMICS, INC.,

13 Plaintiff,

14 vs.

15 KEATING DENTAL ARTS, INC.,

16 Defendant.

17  
18  
19 AND RELATED  
COUNTERCLAIMS.

20 Case No. SACV11-01309-DOC(ANx)

21 **JAMES R. GLIDEWELL DENTAL  
CERAMICS, INC.'S REPLY IN  
SUPPORT OF GLIDEWELL'S  
MOTION FOR PARTIAL  
SUMMARY JUDGMENT RE  
INFRINGEMENT OF A  
FEDERALLY REGISTERED MARK  
(FIRST CAUSE OF ACTION) AND  
DISMISSAL OF DEFENDANT'S  
SECOND AFFIRMATIVE DEFENSE  
AND FIRST COUNTERCLAIM**

22 Hearing

Date: December 17, 2012  
Time: 8:30 a.m.  
Ctrm: 9D, Hon. David O. Carter

23 Pre-Trial Conf.: January 28, 2013  
Jury Trial: February 26, 2013

24 **HIGHLY CONFIDENTIAL - FILED UNDER SEAL**  
25 **(PURSUANT TO PROTECTIVE ORDER DATED JANUARY 30, 2012)**

Snell & Wilmer  
L.L.P.  
LAW OFFICES  
350 South Grand Avenue, Suite 2600, Two California Plaza  
Los Angeles, California 90071  
(213) 929-2500

## 1 2 3            TABLE OF CONTENTS 4 5

		Page
1	I. INTRODUCTION.....	1
2	II. ARGUMENT.....	1
3	A. The Validity of the BruxZir Mark.....	1
4	B. Likelihood of Confusion .....	1
5	1. Strength of the BruxZir Mark.....	1
6	a. Keating's Attack on Glidewell's Evidence .....	1
7	b. Conceptual Strength .....	5
8	c. Commercial Strength.....	7
9	(i) Keating Fails to Address Glidewell's 10 Evidence of Commercial Strength.....	7
11	(ii) Keating's New Naked Licensing Defense .....	9
12	2. Proximity of the Goods.....	11
13	3. Similarity of the Marks .....	11
14	a. "KDZ" Does Not Render the Marks Dissimilar.....	11
15	b. The Oval Does Not Render the Marks Dissimilar .....	12
16	c. Keating's Remaining Arguments Also Fail .....	14
17	4. Actual Confusion .....	15
18	a. The Fallon Declaration .....	15
19	b. The 86 Keating Prescription Forms.....	17
20	c. Keating's "Policy" of Calling Dentists is Nothing but a Vehicle for Profiting on Initial Interest Confusion.....	19
21	d. Keating's "Policy" Prior to the Filing of the Lawsuit: Take Advantage of Actual Source Confusion.....	21
22	5. Marketing Channels .....	22
23	6. Type of Goods and Degree of Care .....	23
24	7. Keating's Intent.....	24
25	8. Likelihood of Expansion of the Product Lines .....	25
26	III. CONCLUSION .....	25
27		
28		

## TABLE OF AUTHORITIES

2	Page
3	<b>CASES</b>
4	<i>3Com Corp. v. Realtek Semiconductor Corp.</i> C 03-2177 VRW, 2008 WL 783383 (N.D. Cal. Mar. 24, 2008).....3
5	
6	<i>Am. Mensa, Ltd. v. Inpharmatica, Ltd.</i> WDQ-07-3283, 2008 U.S. Dist. LEXIS 99394, at *31 (D. Md. Nov. 6, 2008) .....15
7	
8	<i>Anderson v. Liberty Lobby, Inc.</i> 477 U.S. 242 (1986).....2, 4
9	
10	<i>B &amp; B Hardware, Inc. v. Hargis Industries, Inc.</i> 252 F.3d 1010 (8th Cir. 2001).....6
11	
12	<i>Brookfield Communications, Inc. v. West Coast Entertainment Corp.</i> 174 F.3d 1036 (9th Cir. 1999) .....14, 19
13	
14	<i>Cohn v. Petsmart, Inc.</i> 281 F.3d 837 (9th Cir. 2002) .....12
15	
16	<i>Cyntegra, Inc. v. IDEXX Laboratories, Inc.</i> 322 F. App'x 569 (9th Cir. 2009) .....3
17	
18	<i>Donovan v. Crisotomo</i> 689 F.2d 869 (9th Cir.1982) .....16
19	
20	<i>E. &amp; J. Gallo Winery v. Gallo Cattle Co.</i> 967 F.2d 1280 (9th Cir. 1992) .....24
21	
22	<i>Earthquake Sound Corp. v. Bumper Indus.</i> 352 F.3d 1210 (9th Cir. 2003) .....15
23	
24	<i>Echo Drain v. Newsted</i> 307 F. Supp. 2d 1116 .....17
25	
26	<i>Fancaster, Inc. v. Comcast Corp.</i> 832 F. Supp. 2d 380 (D.N.J. 2011) .....5
27	
28	<i>Fuji Photo Film Co., Inc. v. Shinohara Shoji Kabushiki Kaisha and Graphic Mach., Inc.</i> 754 F.2d 591 (5th Cir. 1985) .....23, 24
29	
30	<i>Garvey v. Kmart Corp.</i> C-11-02575-WHA, 2012 U.S. Dist. LEXIS 160006, at *3 (N.D. Cal. Nov. 6, 2012) .....3
31	
32	<i>Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway &amp; Sons</i> 523 F.2d 1331 (2d Cir. 1975) .....19, 20
33	

## **TABLE OF AUTHORITIES**

(continued)

Page	
3	<i>GTFM, Inc. v. Solid Clothing, Inc.</i> 215 F. Supp. 2d 273 (S.D.N.Y. 2002) ..... 8
4	<i>Hendricks v. CBE Grp., Inc.</i> 11-C-2783, 2012 U.S. Dist. LEXIS 49827, at *13 (N.D. Ill. Apr. 10, 2012) ..... 16
5	<i>Hokto Kinoko Co. v. Concord Farms, Inc.</i> 810 F. Supp. 2d 1013 (C.D. Cal. 2011) ..... 10
6	<i>Hutchinson v. Essence Communications, Inc.</i> 769 F. Supp. 541 (S.D.N.Y. 1991) ..... 5
7	<i>Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.</i> 963 F.2d 350 (Fed Cir. 1992) ..... 15
8	<i>KOS Pharmaceuticals, Inc. v. Andrix Corp.</i> 369 F.3d 700 (3d Cir. 2004) ..... 15, 24
9	<i>Lahoty v. Verichheck, Inc.</i> 636 F.3d 501 (9th Cir. 2011) ..... 6
10	<i>Metro Publ'g, Inc. v. Surfmet, Inc.</i> C-02-01833-CW, 2002 U.S. Dist. LEXIS 26232, at *27-28 (N.D. Cal. July 3, 2002) ..... 15
11	<i>Miyano Mach. USA, Inc. v. Miyanohtec Mach., Inc.</i> 576 F. Supp. 2d 868 (N.D. Ill. 2008) ..... 13
12	<i>Nora Beverages, Inc. v. Perrier Group of Am., Inc.</i> 269 F.3d 114 (2d Cir. 2001) ..... 5
13	<i>Norm Thompson Outfitters, Inc. v. General Motors Corp.</i> 448 F.2d 1293 (9th Cir. 1971) ..... 12
14	<i>Nuance Communications, Inc. v. ABBYY Software House</i> C 08-02912 JSW MEJ, 2012 WL 2838431 (N.D. Cal. July 10, 2012) ..... 3
15	<i>Orr v. Bank of Am., NT &amp; SA</i> 285 F.3d 764 (9th Cir. 2002) ..... 18
16	<i>Roe v. Nevada</i> 621 F. Supp. 2d 1039 (D. Nev. 2007) ..... 3, 5
17	<i>Russell v. Daiichi-Sankyo, Inc.</i> CV 11-34-BLG-CSO, 2012 WL 1805038 (D. Mont. May 17, 2012) ..... 3, 4
18	<i>Self-Insurance Ins. of Am., Inc. v. Software &amp; Info. Indus. Ass'n</i> 208 F. Supp. 2d 1058 (C.D. Cal. 2000) ..... 13

## **TABLE OF AUTHORITIES**

(continued)

	Page	
3	<i>SG Servs. v. God's Girls, Inc.</i> CV-06-989-AHM, 2007 U.S. Dist. LEXIS 61970, at *16 (C.D. Cal. May 11, 2007) .....	13
5	<i>Smith v. Mack Trucks, Inc.</i> 505 F.2d 1248 (9th Cir. 1974) .....	4
6	<i>Transgo, Inc. v. Ajac Transmission Parts Corp.</i> 768 F.2d 1001 (9th Cir. 1985) .....	10, 11
8	<i>UGG Holdings, Inc. v. Severn</i> CV04-1137-JFW FMOX, 2005 WL 5887187 (C.D. Cal. Feb. 23, 2005) .....	5
10	<i>Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.</i> 516 F.3d 853 , (10th Cir. 2008) .....	3, 6
11	<i>Volkswagen Astiengesellschaft v. Uptown Motors</i> 91 CIV. 3447(DLC), 1995 WL 605605 (S.D.N.Y. May 11, 1995) .....	5
13	<i>Walter v. Mattel, Inc.</i> 210 F.3d 1108 (9th Cir. 2000) .....	12
14	<b><u>STATUTES</u></b>	
15	15 U.S.C. § 1055 .....	18
16	<b><u>RULES</u></b>	
17	Fed. R. Evid. 602 .....	18

## II. ARGUMENT

## A. The Validity of the BruxZir Mark

Keating asserts that the BruxZir mark is invalid. The mark is valid, for the reasons set forth in Glidewell's Partial Summary Judgment Motion as to Keating's Invalidity Defense and Counterclaim ("Validity Motion") (Dkt. #82) as well as its Opposition to Keating's Motion for Summary Judgment Cancelling Glidewell's Trademark Registration ("Opposition to Keating's Cancellation Motion") (Dkt. #114), both of which are incorporated herein by reference.

### B. Likelihood of Confusion

## **1. Strength of the BruxZir Mark**

a. Keating's Attack on Glidewell's Evidence

Keating devotes half its brief to attacking Glidewell's showing that the BruxZir mark is strong. Rather than address the merits, Keating focuses on attempting to exclude Glidewell's evidence. Keating's complaints are meritless.

1           As an initial matter, it bears noting some of the evidence to which Keating  
 2 does not object. Keating does not object to most of the declaration of James Shuck,  
 3 Glidewell's Vice President of Sales and Marketing, which contains much of the  
 4 evidence concerning the commercial strength of Glidewell's BruxZir mark.  
 5 Keating does not object to Exhibit 76, which shows that Keating presents its KDZ  
 6 Bruxer mark in the marketplace without some of the distinguishing characteristics –  
 7 such as the oval – on which Keating relies to attempt to defeat infringement.

8 Keating does not object to Exhibit 85, [REDACTED] [REDACTED] [REDACTED]  
 9 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
 10 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
 11 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
 12 [REDACTED]. Keating does not object to Exhibit 15, [REDACTED] [REDACTED] [REDACTED]  
 13 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
 14 [REDACTED] And Keating does not object to Exhibit 84, [REDACTED] [REDACTED]  
 15 [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]  
 16 [REDACTED] [REDACTED] [REDACTED] So, even if the Court were to sustain Keating's  
 17 objections (which it should not), there would still be sufficient evidence in the  
 18 record to sustain summary judgment in Glidewell's favor.

19           First, Keating contends that the testimony of Dr. Michael DiTolla and Rudy  
 20 Ramirez, Glidewell's General Manager of Fixed Prosthodontics, is not probative of  
 21 the strength of the BruxZir mark because their testimony is "not objective." This is  
 22 not a basis on which to exclude evidence. *Anderson v. Liberty Lobby, Inc.*, 477  
 23 U.S. 242, 249 (1986). Keating also asserts that their testimony relies on  
 24 inadmissible hearsay. These objections are meritless, for the reasons set forth in  
 25 Glidewell's Responses to Keating's Evidentiary Objections, filed concurrently  
 26 herewith, and in any event do not cover some of the most probative portions of  
 27 these declarations, including Dr. DiTolla's opinion that "BruxZir" is suggestive  
 28 (Dkt. #90-1 [DiTolla Decl. ¶14]). Finally, Keating complains about Dr. DiTolla's

1 statements concerning his discussions with other dentists, on the ground that these  
 2 discussions do not constitute properly-constructed survey evidence. That is correct,  
 3 but immaterial, as Glidewell does not offer Dr. DiTolla's discussions with dentists  
 4 as survey evidence; while Keating's complaint may go to the weight of Dr.  
 5 DiTolla's opinions based on those discussions, it does not affect its admissibility.  
 6 *Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.*, 516 F.3d 853, 861-63, (10th Cir. 2008).

7 Second, Keating asserts that the third party dentists whose declarations were  
 8 submitted by Glidewell were not timely disclosed. This is false. The Scheduling  
 9 Order required that discovery be completed by October 29, 2012. Glidewell  
 10 disclosed all of these dentists as potential witnesses in its First Amended  
 11 Disclosures served on October 29, 2012. (Dkt. #125-3 [Deft's Ex. 140]) They  
 12 were therefore timely disclosed. *Roe v. Nevada*, 621 F. Supp. 2d 1039, 1060 (D.  
 13 Nev. 2007) (rejecting defendant's argument that plaintiff's disclosure of various  
 14 fact witnesses on last day of discovery was untimely); *Nuance Communications,*  
 15 *Inc. v. ABBYY Software House*, C 08-02912 JSW MEJ, 2012 WL 2838431 (N.D.  
 16 Cal. July 10, 2012); *3Com Corp. v. Realtek Semiconductor Corp.*, C 03-2177  
 17 VRW, 2008 WL 783383 (N.D. Cal. Mar. 24, 2008); *Cyntegra, Inc. v. Idexx*  
 18 *Laboratories, Inc.*, CV06-4170PSG(CTX), 2007 WL 5193736 (C.D. Cal. Sept. 21,  
 19 2007) *aff'd*, *Cyntegra, Inc. v. IDEXX Laboratories, Inc.*, 322 F. App'x 569 (9th Cir.  
 20 2009); *Russell v. Daiichi-Sankyo, Inc.*, CV 11-34-BLG-CSO, 2012 WL 1805038  
 21 (D. Mont. May 17, 2012). Keating was not prejudiced by the timing of these  
 22 disclosures: Glidewell offered to forego any objection based on the passing of the  
 23 discovery cut-off should Keating seek to depose these witnesses, but Keating  
 24 declined to do so. (Shaw Decl., ¶ 8, Ex. 115) This offer, incidentally, remains  
 25 open. Keating, therefore, had (and has) the opportunity to cure any prejudice; it's  
 26 refusal to take it does not justify exclusion of these witnesses. *Roe*, 621 F. Supp. 2d  
 27 at 1060 (D. Nev. 2007); *Garvey v. Kmart Corp.*, C-11-02575-WHA, 2012 U.S.  
 28 Dist. LEXIS 160006, at \*3 (N.D. Cal. Nov. 6, 2012).

Snell & Wilmer  
LLP  
LAW OFFICES  
350 South Grand Avenue, Suite 2600, Two California Plaza  
Los Angeles, California 90071  
(213) 929-2500

Keating also asserts a grab-bag of objections that amount to nothing. Keating asks that the Court “not rely on” the declarations of the third-party dentists on the ground that they are Glidewell customers, and are testifying about experiences in the past. These are not grounds to ignore admissible evidence on summary judgment. *Anderson*, 477 U.S. at 249. Keating also asserts that these declarations are not probative of the understanding of dentists generally due to a “selection bias.” However, Keating fails to proffer any evidence or argument by which one could any selection bias (other than, one supposes, the act of counsel in selecting declarations to submit to the Court) exists with respect to these dentists, or that if it did such a bias would so undermine the probative value of their testimony as applied to the community of dentists of which they are a part as to require exclusion. Conclusory allegations that a party’s evidence is not probative is insufficient to avoid summary judgment, *Smith v. Mack Trucks, Inc.*, 505 F.2d 1248, 1249 (9th Cir. 1974), yet that is all that Keating offers.<sup>1</sup>

Third, Keating asserts Dr. Goldstein, Dr. DiTolla and certain portions of Prof. Franklyn’s declarations should be disregarded because the expert reports of these witnesses were not disclosed as required by the Scheduling Order. Once again, the premise is false; the Scheduling Order contains no such schedule. (Dkt. #15) The only limitation on the disclosure of witnesses and expert reports was that contained in the Scheduling Order: that all discovery, including expert discovery, must be completed by the discovery cut-off, October 29, 2012. (*Id.*, p. 2:4-6) So, Glidewell’s amended witness disclosures and expert reports, served on October 29, were timely under the Court’s Scheduling Order. The declarations proffered by these witnesses are not, therefore, subject to exclusion. *E.g., Russell v. Daiichi-Sankyo, Inc.*, CV 11-34-BLG-CSO, 2012 WL 1805038 (D. Mont. May 17, 2012) (holding disclosure of fact witness made on day of discovery cut-off to be timely).

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<sup>1</sup> It bears noting that this argument cuts both ways: if one side’s third party dentist declarations suffer from “selection bias,” then so do the other’s.

1 Moreover, if Keating were in fact prejudiced by the disclosure of these witnesses on  
 2 the last day of discovery, the proper remedy would be to provide Keating an  
 3 opportunity to depose them after the close of discovery. *E.g., Roe v. Nevada*, 621  
 4 F. Supp. 2d 1039, 1060 (D. Nev. 2007). And that is exactly what Glidewell did:  
 5 Glidewell informed Keating that it would make the witnesses under its control  
 6 available for deposition, and would not oppose any effort by Keating to depose  
 7 those witnesses not under Glidewell's control (i.e., the dentist fact witnesses),  
 8 despite the fact that discovery had closed. As with the dentist witnesses, Keating  
 9 declined the offer, which remains open should Keating change its mind. It cannot  
 10 now be heard to complain of any resulting prejudice.

11 Finally, Keating contends that the opinions expressed by Glidewell's experts  
 12 are not probative because they fail to follow the standards required for admissible  
 13 survey data. This argument fails because they are perfectly entitled to rely on their  
 14 general expertise and discussions with dentists and other third parties, *Nora*  
 15 *Beverages, Inc. v. Perrier Group of Am., Inc.*, 269 F.3d 114, 123-24 (2d Cir. 2001);  
 16 *Hutchinson v. Essence Communications, Inc.*, 769 F. Supp. 541, 554 (S.D.N.Y.  
 17 1991); *Fancaster, Inc. v. Comcast Corp.*, 832 F. Supp. 2d 380, 419-20 (D.N.J.  
 18 2011); *UGG Holdings, Inc. v. Severn*, CV04-1137-JFW FMOX, 2005 WL  
 19 5887187, at \*4 (C.D. Cal. Feb. 23, 2005); *Volkswagen Astiengesellschaft v.*  
 20 *Uptown Motors*, 91 CIV. 3447(DLC), 1995 WL 605605, at \*2 (S.D.N.Y. May 11,  
 21 1995), and because Glidewell does not offer them as survey experts.

22                   **b. Conceptual Strength**

23 Keating asserts that Glidewell proffers no admissible evidence as to whether  
 24 dentists would find the mark suggestive. This is incorrect. Glidewell proffered the  
 25 declaration of Dr. Goldstein – a dentist – who opined as to how the dental  
 26 community would understand the BruxZir mark. (Dkt. #90-1 [Goldstein Decl.  
 27 ¶17]) In addition, Glidwell proffered the declaration of Dr. DiTolla – a dentist –  
 28 who opined on the matter as well. (Dkt. #90-1 [DiTolla Decl. ¶14]) In any event,

1 Keating's complaint would be trivial even if true, since Glidewell also proffered the  
 2 declaration testimony of Prof. Franklyn concerning the conceptual strength of the  
 3 mark (Dkt. #90-1 [Franklyn Decl. ¶42]) and of Shuck and Ramirez, both of whom  
 4 testified to facts supporting the conclusion that the mark is suggestive. (Dkt. #90-1  
 5 [Shuck Decl. ¶9; Ramirez Decl. ¶4]) Keating's assertion that none of these  
 6 witnesses but Dr. Goldstein are competent to testify regarding facts pertinent to the  
 7 conceptual strength of the mark is incorrect. Prof. Franklyn is an expert in  
 8 trademark law and so qualified to opine regarding the conceptual strength of the  
 9 BruxZir mark. *Vail Assoc., Inc. v. Vend-Tel-Co., Ltd.*, 516 F.3d 853, 861-63, (10th  
 10 Cir. 2008); *B & B Hardware, Inc. v. Hargis Industries, Inc.*, 252 F.3d 1010, 1012  
 11 (8th Cir. 2001). Dr. DiTolla is a dentist and so even under Keating's test he can  
 12 offer competent evidence. And Shuck and Ramirez testify to facts (not opinions) as  
 13 people who are well acquainted through years of experience in understanding dental  
 14 terminology. This is more than sufficient to render them competent.

15 Keating also contends that Dr. Goldstein's testimony suggests that multi-  
 16 stage reasoning is not required for dentists to leap from BruxZir to bruxers. That is  
 17 not an accurate reading of Dr. Goldstein's declaration. (Dkt. #90-1 [Goldstein  
 18 Decl. ¶17]) In any event, it is not a relevant issue, because the pertinent inquiry is  
 19 not whether multi-stage reasoning or any amount of imagination is required to  
 20 travel the distance from "BruxZir" to a potential user, but rather from "BruxZir" to  
 21 the product, i.e., a full contour zirconia crown indicated for bruxers, among others.  
 22 The evidence shows that it is, and Keating proffers nothing to the contrary. Keating  
 23 cites to four of its dentist declarations for the point that the BruxZir mark is not  
 24 suggestive. However, all of these declarations support Glidewell's position, since  
 25 they acknowledge that "Brux" suggests a person who suffers from bruxism and  
 26 "Zir" suggests zirconia. Those facts alone, even putting aside the existence of the  
 27 registration creating a presumption to the same effect, compel the conclusion that  
 28 the mark is suggestive. *Lahoti v. Vericheck, Inc.*, 636 F.3d 501, 506 (9<sup>th</sup> Cir. 2011).

1                   c.     **Commercial Strength**

2                   (i)    **Keating Fails to Address Glidewell's Evidence of**  

3                   **Commercial Strength**

4                   It is telling that in over six pages of text, Keating fails to meaningfully  
 5 address the substance of Glidewell's evidence of commercial strength. Indeed,  
 6 Keating admits most of the facts demonstrating the commercial strength of the  
 7 BruxZir mark, including the amount of money that Glidewell has spent to market  
 8 goods under the mark (SUF 27-29), the scope and effectiveness of Glidewell's  
 9 Internet and direct mail advertising under the mark (SUF 31-33), the scope of  
 10 Glidewell's advertising in dental industry publications and at trade shows (SUF 35-  
 11 38), Glidewell's recognition in the industry through numerous awards recognizing  
 12 its BruxZir-brand products (SUF 43), and the volume of sales of BruxZir-brand  
 13 product over the past 3 ½ years (SUF 44-46). This is compelling evidence of  
 14 commercial strength, as the *Century 21* and *Conversive* cases hold.

15                  Instead of evidence, Keating offers bromides and distractions. While it is  
 16 true that marketing campaigns are not always successful, the evidence shows that  
 17 Glidewell's was – and Keating proffers absolutely no evidence to dispute that fact.  
 18 Instead, Keating chides Glidewell for failing to produce survey evidence, when it  
 19 was Glidewell that sought a two month continuance of the discovery cutoff for that  
 20 very reason and Keating that opposed it. Keating's suggestion that the Court draw  
 21 an adverse inference here is too clever by half; Glidewell submits that if the Court  
 22 is to draw any inference under the circumstances of this case, it should run against  
 23 Keating, which took advantage of the superior resources of its counsel when  
 24 matched against Glidewell's prior counsel and now seems desperate to avoid  
 25 having to litigate this case on the merits.

26                  Keating also asserts that dental labs typically offer their customers multiple  
 27 options when selecting a crown, then points to a partial image of a Glidewell  
 28 prescription form that offers 23 options. The point of this presentation is not

1 entirely clear. Keating observes that Glidewell does not use an ® symbol next to  
 2 BruxZir; since there is no legal requirement that Glidewell do so, *GTFM, Inc. v.*  
 3 *Solid Clothing, Inc.*, 215 F. Supp. 2d 273, 306 (S.D.N.Y. 2002), and since  
 4 Glidewell appends the symbol to its BruxZir mark in its actual advertising (as  
 5 opposed to its prescription forms), this observation leads nowhere. It certainly does  
 6 not suggest that the mark is generic; indeed, at least one of the other “Zirconia  
 7 Restorations” offered on this form is a registered trademark, (Declaration of Philip  
 8 J. Graves, ¶ 2, Ex. 118) and Glidewell did not put an ® next to it either. One of  
 9 these crowns is named “Lava;” does Keating believe that Glidewell is offering to  
 10 sell crowns made of lava? That is the conclusion to which Keating’s logic leads.

11 Keating also contends that the roughly 180 Authorized BruxZir Labs  
 12 promote BruxZir crowns as a type of crown rather than a source identifier. That  
 13 would be news to these dental labs, the vast majority of which specifically identify  
 14 “BruxZir” on their websites as a registered trademark. This is clearly documented  
 15 in Keating’s own Exhibits 136, to which Keating cites in support of this point; one  
 16 wonders whether Keating even read its own evidence. (Dkt. #93-72 [Def’t’s  
 17 Ex. 136, at, e.g., KDA2862-63, 2865-66, 2873-74, 2879, 2883-84, 2890, 2918,  
 18 2922-23, 2925-26, 2928-29, 2930, 2933-34]) Keating points to 15 dental lab  
 19 prescription forms that list “BruxZir” as a crown that may be purchased, and  
 20 concludes from this that these labs must be using the term to refer to a type of  
 21 product. However, this makes no sense; does the fact that restaurants list Coke and  
 22 Pepsi on their menus without an ® next to them reflect generic use? Of course not,  
 23 and no more so here. While Glidewell could undoubtedly obtain more should the  
 24 Court desire, a sampling of declarations from four of the Authorized BruxZir Labs  
 25 to which Keating points in support of its genericness argument demonstrates that  
 26 the references to BruxZir on the prescription forms are to a particular brand of  
 27 crown, not to a general type of crown. (Declaration of Jacob Trachsel (“Trachsel  
 28 Decl.”), ¶ 2; Declaration of Glen Yamamoto (“Yamamoto Decl.”), ¶ 2; Declaration

1 of Scott Bigler (“Bigler Decl.”), ¶ 2; Declaration of Karen Chamberlain  
2 (“Chamberlain Decl.”), ¶ 2) Thus, there is simply no basis to infer that BruxZir is  
3 used in these forms in a generic sense. Finally, Keating represents that these dental  
4 labs generally do not use an ® next to the BruxZir mark. Here again, false. (Dkt.  
5 #93-72 [Deft’s Ex. 136]; Trachsel Decl. ¶3; Yamamoto Decl. ¶3; Chaimberlain  
6 Decl. ¶3)

Finally, Keating's reliance on the Eggleston report and the declarations of its thirteen dentists is misplaced for the reasons addressed in Glidewell's co-pending Validity Motion and Opposition to Keating's Cancellation Motion.

**(ii) Keating's New Naked Licensing Defense**

Keating next asserts that Glidewell has abandoned the BruxZir mark through “naked licensing,” claiming that Glidewell fails to control the quality of the BruxZir brand crowns sold by the Authorized BruxZir Labs. This is false; Glidewell invests considerable resources into ensuring the quality of the BruxZir brand crowns sold by the authorized labs. Glidewell imposes a rigorous certification process on any lab that seeks to become an Authorized BruxZir Lab, which includes (1) ensuring that the lab has the proper equipment to prepare BruxZir crowns and bridges as required by Glidewell’s Instructions for Use (“IFUs”), (2) training and equipping lab personnel to make BruxZir crowns and bridges that are of the same quality as those made by Glidewell, using the BruxZir-brand zirconia milling blanks sold by Glidewell, (3) sending the IFUs and a test specimen made from a BruxZir-brand zirconia milling blank to the lab and evaluating the specimen after it is processed and returned by the lab, (4) working with any lab that does not pass the validation process to remedy any technical issues, and (5) passing a three-month probation period. (Dkt. #116-1 [Supp. Carden Decl. ¶¶3-6; Supp. Bartolo Decl. ¶¶4-5])

Following certification, the relationship between Glidewell and its Authorized BruxZir Labs remains close. Current IFUs are routinely distributed to Authorized BruxZir Labs which each milling blank order and by email when

1 updated. Glidewell also provides in-person training to its Authorized BruxZir Labs  
 2 by appointment and at BruxZir Summits held at Glidewell, and is in constant  
 3 contact with the labs through its technical support and Glidewell Direct personnel  
 4 to respond to any technical issues on a day to day basis. Glidewell oversees the  
 5 Authorized BruxZir Labs to ensure that they are purchasing BruxZir milling blanks  
 6 and coloring kits; a pattern of consistent orders provides assurance that the labs are  
 7 using genuine BruxZir materials to make their BruxZir brand product, which  
 8 largely ensures that the end-product will have the strength, hardness and aesthetic  
 9 quality that sets BruxZir brand crowns and bridges apart from the competition. In  
 10 addition, Glidewell technical support is available to any dentist that purchased a  
 11 BruxZir crown or bridge from an Authorized BruxZir Lab; this provides a further  
 12 feedback mechanism for quality assurance. (Dkt. #116-1 [Supp. Carden Decl. ¶¶7-  
 13 10; Supp. Bartolo Decl. ¶¶6-19]) In sum, Glidewell provides extensive training,  
 14 support, and instructions to the Authorized BruxZir Labs to ensure that they are  
 15 making BruxZir brand crowns and bridges that are of equal quality to those made  
 16 by Glidewell. (Dkt. #116-1 [Supp. Carden Decl. ¶11; Supp. Bartolo Decl. ¶20])

17 This is more than sufficient to avoid invalidation of Glidewell's BruxZir  
 18 trademark. Keating bears the burden of proving its naked licensing allegation, and  
 19 the standard of proof is "stringent." *Hokto Kinoko Co. v. Concord Farms, Inc.*, 810  
 20 F. Supp. 2d 1013, 1040 (C.D. Cal. 2011). Keating cannot do so by pointing to the  
 21 absence of written license agreements, because such are not required. *Transgo, Inc.*  
 22 v. *Ajac Transmission Parts Corp.*, 768 F.2d 1001, 1017-18 (9<sup>th</sup> Cir. 1985) (no  
 23 naked license despite lack of written license agreement). With respect to  
 24 Glidewell's actual quality control oversight, Keating's evidence is tissue-thin – for  
 25 example, Robin Bartolo explained in his deposition that the Authorized Labs do not  
 26 have to maintain a particular "level of quality" because if they use the IFUs and the  
 27 product supplied by Glidewell "[t]hey should get similar results." (Dkt. #91-5  
 28 [Def't's Ex. 5, p. 64:22 to 65:4]) In other words, quality control is ensured by the

1 labs' use of the BruxZir brand zirconia milling blocks and coloring liquid pursuant  
 2 to the IFUs provided and continuously updated by Glidewell. Of course, here there  
 3 is even more. Glidewell's evidence that it manufactures the zirconia milling blanks  
 4 and coloring liquid that are the key inputs to the fabrication process, that it provides  
 5 ongoing updating of the IFUs and training of lab personnel, and that it obtains  
 6 independent feedback concerning poor-quality BruxZir product, forecloses any  
 7 argument that it has abandoned the BruxZir mark through naked licensing. *E.g.*,  
 8 *Transgo*, 768 F.2d at 1017-18.

## 9       2.     Proximity of the Goods

10      Keating admits that its KDZ Bruxer crowns compete directly with those sold  
 11 by Glidewell under the BruxZir mark. (Dkt. #112-5 [SGI 53]) Accordingly, it is  
 12 undisputed that this factor favors Glidewell.

## 13       3.     Similarity of the Marks

### 14       a.     "KDZ" Does Not Render the Marks Dissimilar

15      With respect to similarity of the marks, Keating contends that its KDZ  
 16 "house mark" provides an "express indicator of source." However, Keating  
 17 proffers vanishingly little evidence to support this assertion. Although Keating  
 18 submitted thirteen dentist declarations, it cites to only two of them – Drs. Campbell  
 19 and Stephens – in support of this "fact." (Dkt. #112-5 [SGI 65]) However, Dr.  
 20 Campbell states that when ordering a different Keating product in 2009 (two years  
 21 before Keating began using the KDZ Bruxer mark), he understood KDZ to refer to  
 22 "Keating Dental Zirconia." (Dkt. #99 [Campbell Decl. ¶6]) That leaves Dr.  
 23 Stephens as Keating's sole support – yet he testifies only as to his own  
 24 understanding, not as to the understanding of dentists generally. Moreover,  
 25 although Keating attaches a handful of fee schedules and brochures to the  
 26 declaration of Shaun Keating (Dkt. #95), the only evidence of actual distribution is  
 27 that some of these items were distributed to Keating's existing customers. (Dkt.  
 28 #95, ¶¶4-5, 7-9) Keating proffers no evidence that it has ever engaged in any

1 promotion of its purported “KDZ” house brand to the dental community outside its  
 2 own customer base. There is, therefore, no basis on which to conclude that these  
 3 three letters serve a source-identifying function in the dental community at large.

4 Keating cites three cases in support of its position, none of which is on point.  
 5 In *Cohn v. Petsmart, Inc.*, 281 F.3d 837, 841-42 (9th Cir. 2002), the court held that  
 6 consumers would encounter the marks differently in the marketplace, because both  
 7 parties used the mark merely as a following tagline to their distinctive business  
 8 names, which presented the “dominant commercial identity.” This is not the case  
 9 with BruxZir and KDZ Bruxer because these marks are not presented as mere  
 10 taglines to company names. In *Walter v. Mattel, Inc.*, 210 F.3d 1108, 1111 (9th  
 11 Cir. 2000), the court determined that the Walter’s “Pearl Beach” mark was  
 12 dissimilar to Mattel’s “Pearl Beach Barbie,” because the Walter’s mark was in plain  
 13 font sometimes accompanied by a monochromatic seashell, whereas Mattel’s “Pearl  
 14 Beach Barbie” was in wavy text with a bright pink clamshell and always  
 15 incorporated a reference to Barbie, which was the dominant part of the mark. *Id.*  
 16 Here, by contrast, the KDZ Bruxer and BruxZir marks are highly textually similar  
 17 as presented in the marketplace, the BruxZir mark is not accompanied by a  
 18 distinguishing logo or design, and Keating has presented no evidence that “KDZ”  
 19 has the source-identifying power that “Barbie” did in the *Walter* case. Finally,  
 20 *Norm Thompson Outfitters, Inc. v. General Motors Corp.*, 448 F.2d 1293 (9th Cir.  
 21 1971), did not even involve the Lanham Act, and the case involved a slogan  
 22 (“Escape from the Ordinary”) that was held to be descriptive and without secondary  
 23 meaning. In all of these cases most or all of the other applicable factors disfavored  
 24 confusion – indeed, in *Norm Thompson* the Ninth Circuit characterized the goods as  
 25 “so vastly different that is difficult to regard confusion as possible.” *Id.* at 1298.  
 26 They provide no guidance here.

27                   **b.     The Oval Does Not Render the Marks Dissimilar**

28 Keating also asserts that the oval around “KDZ” saves it. While it is true that

1 Glidewell's BruxZir mark does not include an oval, the mere use of a distinguishing  
 2 design or logo does not necessarily suffice to foreclose infringement; if that were  
 3 so, then any junior user could appropriate the goodwill of another's mark by simply  
 4 placing an oval, square or circle around it. *Miyano Mach. USA, Inc. v. Miyanohtec*  
 5 *Mach., Inc.*, 576 F. Supp. 2d 868 (N.D. Ill. 2008). Keating cites to *Self-Insurance*  
 6 *Ins. of Am., Inc. v. Software & Info. Indus. Ass'n*, 208 F. Supp. 2d 1058 (C.D. Cal.  
 7 2000), in support of its "distinctive oval" argument. However, in *Self-Insurance*  
 8 the plaintiff's mark was a composite consisting of "SIIA" and a large eagle that was  
 9 the dominant part of the mark; the court held that "SIIA" was a descriptive  
 10 acronym, and the plaintiff acknowledged that it had no rights in "SIIA" without an  
 11 accompanying eagle design. The defendant's mark consisted of "SIIA" and a  
 12 circle, with "Software and Information Industry Association" spelled out  
 13 underneath. Contrary to Keating's parenthetical, the court did not focus on the  
 14 "SIIA" component of these marks, but rather on everything but the "SIIA"  
 15 component. *Id.* at 1071. The facts here compel a different result: Glidewell did not  
 16 have to rely on some design element in order to obtain a registration for its BruxZir  
 17 mark and does not submerge "BruxZir" within a composite design-based mark, and  
 18 Keating does not spell out its company name as part of its mark.

19 In *SG Servs. v. God's Girls, Inc.*, CV-06-989-AHM, 2007 U.S. Dist. LEXIS  
 20 61970, at \*16 (C.D. Cal. May 11, 2007), the district court determined that the  
 21 plaintiff's mark – a logo consisting of a drawing of a woman's head with "SG"  
 22 written underneath in stylized font – used to brand the plaintiff's "alterna-porn"  
 23 website was visually dissimilar to the defendant's mark – "GG" with no drawing  
 24 and with the "G's" reversed into mirror images of one another. *Id.* at \*16. Here,  
 25 Keating's oval lacks the visual impact of an image of a woman's head – a human  
 26 visage is a unique image in its own right and calculated to draw the eye,  
 27 particularly, one would think, in the context of a website dedicated to pornography  
 28 – and the fonts used in the KDZ Bruxer and BruxZir marks are largely identical. In

1 addition, the balance of the *Sleekcraft* factors favored the defendant, whereas here  
 2 they favor Glidewell. *SG Services* is not on point.

3                   c.     Keating's Remaining Arguments Also Fail

4 Keating also contends that the likelihood of confusion is reduced because  
 5 Keating is using a descriptive word – Bruxer. Keating here appears to be advancing  
 6 a version of its fair use argument, which is addressed in Glidewell's Motion for  
 7 Partial Summary Judgment re Misuse (Dkt. #79-1) and the reply in support of that  
 8 motion filed concurrently with this brief. The problem here is that “bruxer” does  
 9 not describe a zirconia crown, but rather a group of potential patients (among  
 10 several others) for whom the crown may be indicated, as explained in Glidewell's  
 11 Validity Motion and Opposition to Keating's Cancellation Motion. The word is  
 12 therefore not descriptive with respect to crowns and bridges, which are the goods at  
 13 issue in this suit. Neither Glidewell nor Keating sells people who suffer from  
 14 bruxism; they sell dental crowns and bridges. For the same reason, it is simply  
 15 irrelevant that some dental labs describe zirconia crowns as a good choice for  
 16 bruxers, as the term “bruxers” here is not being used to describe the goods (the  
 17 crowns) but rather a group of people who might use the crowns. This is similar to  
 18 the *Brookfield* case, in which the Ninth Circuit held that the mark MOVIE BUFF –  
 19 which described the group of people who would be likely to use the entertainment  
 20 industry database software offered under the mark – was suggestive, and not  
 21 descriptive, because it did “not describe either the software product or its purpose.”  
 22 *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d  
 23 1036, 1058 (9<sup>th</sup> Cir. 1999).

24 Keating also observes that it disclaimed the work “Bruxer” in its application  
 25 to register the KDZ Bruxer mark. The relevance of this observation is elusive.  
 26 While a disclaimer by the owner of an asserted mark may indicate that the  
 27 disclaimed portion is weak, there is no authority (and Keating cites none)  
 28 suggesting that a disclaimer by the accused infringer has the same effect.

Keating also chides Glidewell for only citing two cases involving marks that share only a suffix. The following cases, among others that Glidewell could cite, should suffice to carry the point: *Earthquake Sound Corp. v. Bumper Indus.*, 352 F.3d 1210, 1217-18 (9th Cir. 2003) (EARTHQUAKE and CARQUAKE confusingly similar); *KOS Pharmaceuticals, Inc. v. Andrix Corp.*, 369 F.3d 700, 714-715 (3d Cir. 2004) (ADVICOR and ALTOCOR confusingly similar); *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 354-55 (Fed Cir. 1992) (PLAY-DOH and FUN DOUGH confusingly similar); *Metro Publ'g, Inc. v. Surfmet, Inc.*, C-02-01833-CW, 2002 U.S. Dist. LEXIS 26232, at \*27-28 (N.D. Cal. July 3, 2002) (METRO and SURFMETRO confusingly similar); *Am. Mensa, Ltd. v. Inpharmatica, Ltd.*, WDQ-07-3283, 2008 U.S. Dist. LEXIS 99394, at \*31 (D. Md. Nov. 6, 2008) (“Admensa” and MENSA confusingly similar).

#### **4. Actual Confusion**

**a. The Fallon Declaration**

First, Keating asserts that the Court should exclude the declaration of Nicole Fallon, because it purportedly contradicts Glidewell's interrogatory responses.

25 Keating contends that this declaration represents a “new” presentation of  
26 Fallon. However, upon examination the “contradiction” collapses [REDACTED]  
27 [REDACTED] In all material respects, Fallon’s  
28 declaration is perfectly consistent with Glidewell’s prior interrogatory responses

1 [REDACTED]  
 2 [REDACTED]  
 3 [REDACTED] Keating cites no authority for the  
 4 proposition that a party is precluded from proffering evidence that provides details  
 5 lacking in its prior interrogatory responses; if that were the rule, the interrogatory  
 6 process would become unworkable. Absent violation of a court order or an actual  
 7 material contradiction, courts routinely permit parties to supplement pre-trial  
 8 disclosures with additional detail in declarations submitted in connection with  
 9 summary judgment briefing. *Donovan v. Crisotomo*, 689 F.2d 869, 875 (9th  
 10 Cir.1982); *Hendricks v. CBE Grp., Inc.*, 11-C-2783, 2012 U.S. Dist. LEXIS 49827,  
 11 at \*13 (N.D. Ill. Apr. 10, 2012) (holding declarant's deposition admissible even  
 12 though it differed from a response in a previous interrogatory). There is no basis to  
 13 exclude either the Fallon declaration or Exhibits 1-2.

14 Keating also complains that it was not provided an opportunity to examine  
 15 Fallon. [REDACTED]  
 16 [REDACTED]  
 17 [REDACTED]  
 18 [REDACTED]

19 [REDACTED]  
 20 [REDACTED] This is not a ground to exclude Fallon's declaration.

21 Turning to the merits, Keating contends that the [REDACTED]  
 22 [REDACTED]  
 23 [REDACTED]  
 24 [REDACTED]  
 25 [REDACTED]  
 26 [REDACTED]  
 27 [REDACTED]  
 28 [REDACTED]

1 [REDACTED]  
 2 [REDACTED]  
 3 [REDACTED]  
 4 [REDACTED]  
 5 [REDACTED] 180 [REDACTED]  
 6 [REDACTED]  
 7 [REDACTED]  
 8 [REDACTED]  
 9 [REDACTED]  
 10 [REDACTED]

11 *Echo Drain v. Newsted*, 307 F. Supp. 2d 1116, 1126–27 (C.D. Cal. 2003), is not on  
 12 point because it involved letters from real friends and because nothing suggested  
 13 that members of the public would actually be confused. Here, that is exactly the  
 14 danger that Keating's KDZ Bruxer mark creates, a danger heightened by the fact  
 15 that Glidewell's BruxZir-brand crowns are sold not only by Glidewell but also by a  
 16 network of 180 authorized third party dental labs – dental labs just like Keating.

17                   **b.     The 86 Keating Prescription Forms**

18 In its moving papers, [REDACTED]  
 19 [REDACTED]  
 20 [REDACTED]  
 21 [REDACTED]  
 22 [REDACTED]  
 23 [REDACTED]  
 24 [REDACTED]  
 25 [REDACTED]  
 26 [REDACTED]  
 27 [REDACTED]  
 28 [REDACTED]

1 [REDACTED]  
 2 [REDACTED],  
 3 [REDACTED]  
 4 [REDACTED]  
 5 [REDACTED]  
 6 [REDACTED]  
 7 [REDACTED]  
 8 [REDACTED]  
 9 [REDACTED]  
 10 [REDACTED] the [REDACTED]  
 11 [REDACTED]  
 12 [REDACTED]  
 13 [REDACTED]  
 14 [REDACTED]  
 15 [REDACTED]  
 16 [REDACTED]  
 17 [REDACTED]

18 However, even were the Brandon declaration admissible on this point, that  
 19 would not end the matter. Even were it true that these dentists intended to order a  
 20 zirconia crown from Keating, this proves little. The owner of a mark may properly  
 21 authorize third parties to sell products under the mark; indeed, when it does so the  
 22 sales of those products inure to the benefit of the owner of the mark. 15 U.S.C. §  
 23 1055. Here, exactly such a structure is implemented through the network of  
 24 approximately 180 Authorized BruxZir Labs, which both compete with Glidewell  
 25 (by selling competitors' and sometimes their own products) and sell BruxZir-brand  
 26 crowns that they make according to Glidewell's specifications by using the zirconia  
 27 milling blanks and coloring liquid supplied by Glidewell. Because of this  
 28 distribution structure, it would not be at all unusual for a dentist to order a BruxZir-

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1 brand crown from a dental lab other than Glidewell. [REDACTED]  
 2 [REDACTED]  
 3 [REDACTED]  
 4 [REDACTED] The BruxZir mark need not be associated in a  
 5 dentist's mind with Glidewell or any other particular dental lab in order for it to  
 6 serve as a sigil of quality and therefore to drive customers to knowingly purchase  
 7 Keating's crowns under the confusingly similar KDZ Bruxer mark. *Grotrian,*  
 8 *Helfferich, Schulz, Th. Steinweg Nachf. V. Steinway & Sons*, 523 F.2d 1331, 1341-  
 9 42 (2d Cir. 1975).

10           c.     Keating's "Policy" of Calling Dentists is Nothing but a  
 11                   Vehicle for Profiting on Initial Interest Confusion

12 [REDACTED]  
 13 [REDACTED]  
 14 [REDACTED]  
 15 [REDACTED]  
 16 [REDACTED]  
 17 [REDACTED]

18       The Ninth Circuit recognizes that a party's trademark may be wrongfully  
 19 appropriated by another to generate "initial interest confusion," in which the senior  
 20 user's mark is appropriated by a junior user to generate initial interest or credibility  
 21 among the consuming public, even if consumers are likely to realize that they are  
 22 dealing with the junior user rather than the senior when the actual sale is made.  
 23 *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d  
 24 1036, 1057, 1061-65 (9<sup>th</sup> Cir. 1999). The doctrine has been applied in many cases  
 25 both in the online context (as in Brookfield) and the bricks and mortar context. *Id.*  
 26 at 1063-64 (collecting cases). The progenitor of this line of authority, the Second  
 27 Circuit's opinion in *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway*  
 28 & Sons, 523 F.2d 1331, 1341-42 (2d Cir. 1975), involved a piano company that

1 sold its goods under the “Grotrian-Steinweg” mark. The Second Circuit held that  
 2 actual or potential confusion at the time of purchase need not be shown, as the  
 3 initial credibility garnered by the confusingly similar junior mark may suffice for  
 4 infringement:

5 The issue here is not the possibility that a purchaser would buy a Grotrian-  
 6 Steinweg thinking it was actually a Steinway or that Grotrian had some  
 7 connection with Steinway and Sons. The harm to Steinway, rather, is the  
 8 likelihood that a consumer, hearing the “Grotrian-Steinweg” name and  
 9 thinking it had some connection with “Steinway,” would consider it on that  
 10 basis. The “Grotrian-Steinweg” name therefore would attract potential  
 11 customers based on the reputation built up by Steinway in this country for  
 12 many years.

13 *Id.* at 1342.

14 [REDACTED]  
 15 [REDACTED]  
 16 [REDACTED]  
 17 [REDACTED]  
 18 [REDACTED]  
 19 [REDACTED]  
 20 [REDACTED]  
 21 [REDACTED]  
 22 [REDACTED]  
 23 [REDACTED]  
 24 [REDACTED] confirmed [REDACTED] they [REDACTED] to [REDACTED] [REDACTED]  
 25 [REDACTED]  
 26 [REDACTED]  
 27 [REDACTED]  
 28 [REDACTED]

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1 [REDACTED]  
2 [REDACTED]  
3 [REDACTED]  
4 [REDACTED]  
5 [REDACTED]  
6 [REDACTED]  
7 [REDACTED]  
8 [REDACTED]  
9 [REDACTED]  
10 [REDACTED]  
11 [REDACTED]  
12 [REDACTED]  
13 [REDACTED]  
14 [REDACTED]  
15 [REDACTED]  
16 [REDACTED]  
17 [REDACTED]  
18 [REDACTED]

19           d. **Keating's "Policy" Prior to the Filing of the Lawsuit:**  
20                   **Take Advantage of Actual Source Confusion**

21 [REDACTED]  
22 [REDACTED]  
23 [REDACTED]  
24 [REDACTED]  
25 [REDACTED]  
26 [REDACTED]  
27 [REDACTED]  
28 [REDACTED]

1 [REDACTED]  
2 [REDACTED]  
3 [REDACTED]  
4 [REDACTED]  
5 [REDACTED]  
6 [REDACTED]  
7 [REDACTED]  
8 [REDACTED]  
9 [REDACTED]  
10 [REDACTED]  
11 [REDACTED]  
12 KDZ Bruxer [REDACTED] alkmire. [REDACTED]  
13 [REDACTED]  
14 [REDACTED]  
15 [REDACTED]  
16 [REDACTED]  
17 [REDACTED]  
18 [REDACTED]  
19 [REDACTED]  
20 [REDACTED]  
21 [REDACTED]  
22 [REDACTED]  
23 [REDACTED]  
24 [REDACTED]  
25 [REDACTED]

26 **5. Marketing Channels**

27 Keating admits that its KDZ Bruxer crowns are marketed through nearly  
28 identical channels as are Glidewell's BruxZir-brand crowns. (Dkt. #112-5 [SGI 88-

1 90]) Accordingly, it is undisputed that this factor favors Glidewell.

2       **6. Type of Goods and Degree of Care**

3           Keating does not dispute that the properties of full contour zirconia crowns  
 4 are highly similar regardless of brand, and that dentists may regard Glidewell's  
 5 BruxZir brand crowns and Keating's KDZ Bruxer crowns as interchangeable. (Dkt.  
 6 #112-5 [SGI 91-92]) While Keating criticizes Dr. DiTolla's supporting declaration  
 7 as hearsay (it is not), it proffers no evidence to contradict Dr. DiTolla's statements  
 8 on this issue. Accordingly, these facts stand undisputed.

9           Instead of addressing the issue directly, Keating asserts that dentists are  
 10 highly educated professionals who care about their patients. This is not disputed, as  
 11 it is irrelevant. Glidewell does not contend that the standard of care in dentistry is  
 12 low, but rather that the evidence shows that dentists do not exercise a high degree  
 13 of care in selecting one brand of full contour zirconia crown over another. Keating  
 14 states that the price differential between Glidewell and Keating crowns is  
 15 substantial, but proffers no evidence that any dentist would consider it so. The  
 16 closest that Keating approaches to probative evidence is paragraph 12 of the  
 17 Eggleston declaration submitted with its Motion re Non-Infringement, in which Dr.  
 18 Eggleston states that he is careful in choosing the dental professionals with whom  
 19 he works, including dental labs. Notably, Dr. Eggleston abjures any broad  
 20 statement concerning the practices of dentists in general, and speaks only for  
 21 himself. Thus, Keating's evidence concerning the degree of care exercised by  
 22 dentists in selecting a dental lab consists solely of the statement of Dr. Eggleston  
 23 concerning his own practice, nothing more.

24           Moreover, this evidence, even were it probative of the practices of dentists in  
 25 general, would still miss the mark, because the issue is not whether dentists are  
 26 careful in choosing dental labs, but rather the degree of care they exercise in  
 27 choosing one brand of a specific type of crown – a full contour zirconia crown –  
 28 over another brand of the same type of crown. *Fuji Photo Film Co., Inc. v.*

1        *Shinohara Shoji Kabushiki Kaisha and Graphic Mach., Inc.*, 754 F.2d 591, 595-96  
 2        (5th Cir. 1985); *KOS Pharmaceuticals, Inc. v. Andrx Corp.*, 369 F.3d 700, 716 n.  
 3        12 (3d Cir. 2004). Most dental labs sell multiple brands of crowns and bridges, so  
 4        the selection of a particular dental lab does not result in the selection of a particular  
 5        brand of crown. (Dkt. #93-72 [Deft's Ex. 136]) This is the case for Keating, just as  
 6        it is for Glidewell. (Dkt. #125-1 [Deft's Ex. 138]; Dkt. #90-4 [Ex. 15, KDA2029])  
 7        Dr. Eggleston says nothing regarding the degree of care he exercises in choosing  
 8        one brand of crown over another; that is likely because, as Dr. DiTolla explains,  
 9        they are largely functionally interchangeable. Glidewell's evidence is unrebutted.

10       Finally, Glidewell cited several cases in its opening brief squarely rejecting  
  11       the generalized "doctors are careful" argument that Keating makes here, and  
  12       Keating responds to none of them. Glidewell cited the *Conversive* case for the  
  13       point that actual confusion by sophisticated consumers (such as the dentists here)  
  14       strengthens the conclusion that confusion is likely; Keating fails to respond.  
  15       Glidewell noted that initial interest confusion is still a concern even if a high degree  
  16       of care is exercised (which, the evidence shows, is not the case here); silence from  
  17       Keating. Keating proffers neither probative evidence nor legal argument to rebut  
  18       Glidewell's showing. The undisputed evidence on the degree of care factor favors  
  19       Glidewell.

20       **7. Keating's Intent**

21       In its moving papers, Glidewell proffered evidence that Keating was aware of  
  22       Glidewell's BruxZir mark when it made the decision to apply the KDZ Bruxer  
  23       brand to its competing crowns. [REDACTED] Obviously, if Keating did  
  24       [REDACTED] not in fact know of the mark in early 2011 it could say so now; it says nothing. The  
  25       only reasonable conclusion is that Keating knew of the BruxZir mark when it  
  26       adopted its KDZ Bruxer mark; this supports a finding that Keating intended to  
  27       confuse. *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1293 (9th Cir.  
  28       9th Cir. 1992).

1 1992).

2 Keating's arguments on this issue are specious. Keating suggests that  
3 Glidewell is attacking its decision to engage counsel to conduct a trademark search.  
4 Not so; what Glidewell attacks is Keating's decision to go forward with the brand  
5 after undoubtedly having been informed of the priority of Glidewell's registered  
6 BruxZir mark. Keating's excuse for its failure to produce the trademark search  
7 report – that it never obtained a copy from counsel, an explanation provided for the  
8 first time in its opposition brief – merely illustrates a different species of discovery  
9 misconduct from that suspected by Glidewell, as Keating was obligated to obtain  
10 the search report from its counsel and produce it during discovery.

11 **8. Likelihood of Expansion of the Product Lines**

12 As Glidewell has located Ninth Circuit authority that indicates that where the  
13 parties already directly compete the "likelihood of expansion" factor is  
14 unimportant, it concedes that this factor favors neither side.

15 **III. CONCLUSION**

16 For the reasons set forth above, the Court should grant Glidewell's Motion  
17 for Partial Summary Judgment re Infringement.

18 Dated: December 3, 2012

SNELL & WILMER L.L.P.

By:  
Philip J. Graves  
Greer N. Shaw

23 Attorneys for Plaintiff  
24 James R. Glidewell Dental Ceramics, Inc. dba  
25 GLIDEWELL LABORATORIES

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1                   ***Glidewell Laboratories v. Keating Dental Arts, Inc.***  
2                   United States District Court, Central, Case No. SACV11-01309-DOC (ANx)

3                   **CERTIFICATE OF SERVICE**

4                   I hereby certify that on December 3, 2012, I electronically filed the document  
5                   described as **JAMES R. GLIDEWELL DENTAL CERAMICS, INC.'S REPLY**  
6                   **IN SUPPORT OF GLIDEWELL'S MOTION FOR PARTIAL SUMMARY**  
7                   **JUDGMENT RE INFRINGEMENT OF A FEDERALLY REGISTERED**  
8                   **MARK (FIRST CAUSE OF ACTION) AND DISMISSAL OF**  
9                   **DEFENDANT'S SECOND AFFIRMATIVE DEFENSE AND FIRST**  
10                  **COUNTERCLAIM** with the Clerk of the Court using the CM/ECF System which  
11                  will send notification of such filing to the following:

12                  David G. Jankowski  
13                  Jeffrey L. Van Hoosear  
14                  Lynda J Zadra-Symes  
15                  Knobbe Martens Olson and Bear LLP  
16                  2040 Main Street, 14th Floor  
17                  Irvine, CA 92614

18                  **Attorneys for Defendant Keating**  
19                  **Dental Arts, Inc.**  
20                  Tel: (949) 760-0404  
21                  Fax: (949) 760-9502

22                  Jeffrey.vanhoosear@kmob.com  
23                  David.jankowski@kmob.com  
24                  Lynda.zadra-symes@kmob.com  
25                  litigation@kmob.com

26                  Dated: December 3, 2012

27                  SNELL & WILMER L.L.P.

28                  By: *s/Philip J. Graves*  
29                  Philip J. Graves  
30                  Greer N. Shaw

31                  Attorneys for Plaintiff  
32                  James R. Glidewell Dental Ceramics, Inc.  
33                  dba GLIDEWELL LABORATORIES

34                  16139994.1